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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,459	09/13/2000	Morikatsu Matsuda	000004.000661	2151

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EXAMINER

GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,459

Applicant(s)

MATSUDA ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The Amendment filed on June 6, 2002 has been entered.
2. Receipt is acknowledged of the Change of Address/Power of Attorney filed on July 11, 2002. However, this communication has not been entered due to the fact that the changed address is the same as that already of record.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 10 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. In claim 1, ll. 18-19, the phrase "along another direction which is parallel to the first direction" is vague and indefinite in that it is not clear what the clause encompasses. How is "another direction" parallel to a given direction? In the working planar surface as shown in Fig. 1, would not both directions be the same? How is this parallel direction different from the first?
- ii. Claim 15 is vague and indefinite in that it appears to be redundant. The plural nature of the clamps has already been set forth in claim 16.
- iii. In claim 16, l. 10, the phrase "a size" is vague and indefinite in that it appears to be a double inclusion of the same previously recited.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 10 are 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn.

Dunn discloses a linear punch press comprising all the elements claimed including, *inter alia*, a body frame 20, 22, 30; a table 78; a first positioning device 86, 106, 106a for positioning a work piece in a first direction, wherein the first positioning device includes a first clamp (e.g., 106, Fig. 10) to clamp a first margin of the work pieces and a second clamp (e.g., 106a, Fig. 10) to clamp a second margin opposite to the first margin of the work piece, wherein the first clamp can be moved to approach the second clamp (see e.g. Fig. 10 and c. 3, ll. 53-59 which clearly shows the clamps 106 and 106a with either one adjustably slidably approaching each other); a second positioning device 86, 106, 106a (see Fig. 2) for positioning the work piece in the first direction; a working head 22 positionable in a second direction perpendicular to the first, wherein the positioning devices are arranged in series. See Figs. 1-13, c. 2, l. 31 - c. 5, l. 51.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

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various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Graf et al.

Dunn discloses the invention substantially as claimed except for the work piece being a material uncoiled from a coiled material. However, although Dunn is silent as to the sheet work piece being from coiled material, it is old and well known in the art to utilize the device and method of Dunn for punching sheet material uncoiled from a coiled material as evidenced by Graf et al. Graf et al clearly teaches a punching device and method wherein positioning devices 80, 105 are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station 1 (see Fig. 1) for the inherent advantage of machine processing economy, i.e. less down time caused by intermittent feeding of discontinuous work piece sheets, that a longer continuous work piece material affords. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device and method of Dunn with the coiled material as taught by Graf et al for the reasons stated *supra*.

Alternatively, the coiled material has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, with respect to the apparatus claims, the claimed “coiled material” fails to further limit the structure of the invention to the extent necessary for any significant patentable consideration since the work piece itself does not define any *structure*. The claims also lack any specific structural detail that is distinctive for the “coiled material.” Thus, for all the foregoing reasons, it is not subject to significant patentable weight.

Response to Arguments

10. Applicant's arguments filed October 17, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Dunn does not anticipate the claimed invention,¹ this argument lacks merit. First, it is noted that the argued points are substantially the same as presented in the previous amendment.² Thus, the Examiner's response thereto equally applies.³ Second, Applicant's assertion that Dunn does not have the first and second positioning devices alternately transfer the workpiece during the punching operation is off point when the claim merely recites that these positioning devices “may” so perform. In that regard, even if Dunn may not specifically state that the noted positioning devices alternately transfer, it does not detract from the fact that the positioning devices in Dunn are constructed so that they “may” alternately transfer a workpiece since the term “may” is not a positive statement to that effect. In

¹ Amendment C, Paper No. 13, p. 5, l. 15 - p. 6, l. 3.

² Note Supplemental Amendment, Paper No. 10, p. 5, ll. 1-9.

other words, the term “may” is so broad that it does not overcome the rejections *supra*. Moreover, no significant patentable weight has been given to the “coiled material” *per se* due to the fact that this alleged “limitation” is regarding the workpiece, and there is no structure in the relevant claims that further limit the claimed invention to the extent necessary for such consideration since the work piece itself does not define any *structure*. The claims also lack any specific structural detail that is distinctive for the “coiled material.”

Regarding Applicant’s arguments traversing the teachings of Graf et al and Kindgren et al,⁴ these arguments lack merit due to the fact that they are a piecemeal analysis of the references. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

³ See last Office Action, Paper No. 11, p. 7, ¶ 12.

⁴ Amendment C, p. 6, ll. 6-12.


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

cg 
August 26, 2002


Charles Goodman
Primary Examiner
AU 3724

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RIMARY EXAMIN